

REMARKS

Applicants gratefully acknowledge the Examiner's withdrawal of the finality of the rejection in the previous office action.

Independent Claims 3-4 and dependent Claims 6-10 are currently pending in the application. Claims 3 and 4 have been amended by deleting the phrase "without distinction" (Claim 3, line 6; Claim 4, line 7) in response to the Examiner's comments. No new matter has been added.

Independent Claims 3-4 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In addition, Claims 3-4 and 6-10 have been rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,167,383 to Henson in view of Official Notice.

Applicants respectfully traverse on the grounds (a) that Claims 3 and 4 meet the requirements of 35 U.S.C. § 112, second paragraph, particularly in view of the current amendments, and (b) that Claims 3-4 and 6-10 would not be suggested to one of ordinary skill in the art by Henson in view of Official Notice. Applicants also traverse on the basis that the rejection is based on impermissible hindsight.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The rejection of Claims 3 and 4 for indefiniteness under 35 U.S.C. § 112, second paragraph, is based, in part, on a finding that the phrase "without distinction" does not enable one of ordinary skill in the art to reasonably appraise the scope of the invention. While Applicants consider that finding to be erroneous, it has been addressed by deleting the phrase "without distinction" (Claim 3, lines 6-7; Claim 4, line 7) as noted above.

The Examiner also erroneously found the terms "front end" and "back end" as not sufficient to enable one of ordinary skill in the art to reasonably appraise the scope of the invention. In response, Applicants respectfully point out that the term "front end" is well-known and commonly used in the art to refer to the input side in a computer system,

while the term “back end” is well-known and commonly used in the art to refer to the support components of a computer system. (*See also* Specification at page 3, lines 15-19; page 6, lines 9-15; and page 6, line 25, to page 7, line 7)

The Examiner erroneously found the terms “virtual entitled groups” and “ancillary e-commerce solutions” to be indefinite. Those terms are transparent to one of ordinary skill in the art, and their application to Claims 3 and 4 is made completely clear by the Specification at page 5, line 20, to page 6, line 3; at page 6, lines 4-24; and at page 6, line 25, to page 7, line 7, among other places.

Finally the Examiner erroneously found the term “bundle definition process” to be indefinite. The term “process” is a fundamental term of art which signifies the manipulation of data in a computer. With regard to “bundle definition,” the Specification at page 5, lines 16-20, clearly identifies the four elements required to define a customizable solution bundle.

Thus, Applicants respectfully submit that the Claims 3 and 4, as amended, meet the definiteness requirements of 35 U.S.C. § 112, second paragraph.

Rejection Under 35 U.S.C. § 103(a)

In rejecting Claims 3-4 under 35 U.S.C. § 103(a), the Examiner has for the most part restated the rejection under 35 U.S.C. § 102 in the previous office action, with minor revisions. Applicants’ response to the previous office action is, therefore, incorporated by reference.

The Examiner’s obviousness rejection depends largely upon a reading of Henson which ignores that fact that Henson does not enable the mixing and matching of items between different customer sets. According to Henson, “[a] customer . . . may not have items taken from two specialty stores within the cart at one time for the following reason. Processing items from two different specialty stores in one cart is illogical to the online store.” (Henson, column 10, lines 57-61) The Examiner effectively recognizes this by stating that “Henson does process each virtual entitled group with selected products for

that customer set or another customer set” (Office Action at 9) (emphasis added) but does not acknowledge that Henson cannot permit items from one customer set to be made available to a customer working from another customer set. Because Henson requires each customer set to be limited to predetermined items, virtual entitled groups as claimed by independent Claims 3 and 4 of the claimed invention cannot be implemented according to the disclosure of Henson.

The Examiner has also rejected independent Claims 3-4 and dependent Claims 6-10 under 35 U.S.C. § 103(a) as obvious under Henson in view of Official Notice that “it was old and well known . . . that a sales rep would apply incentives such as price where appropriate.” (Office Action at 7, omitted) The mere fact that price incentives are not new, however, does not make it possible for such incentives to be added to the disclosure of Henson to result in the claimed invention. Even if price incentives were made available on a customer set-by-customer set basis according to the disclosure of Henson, the result would not be the claimed invention because it would not use the “virtual entitled groups” of Claims 3 and 4.

The Examiner’s attempt to use Official Notice in this way is also an application of impermissible hindsight and an improper assertion of technical fact in an area of esoteric technology without support by citation of any reference work. *See* M.P.E.P. § 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 422-21 (C.C.P.A. 1970)). While the Examiner does cite to Paragraph 0128 of U.S. Patent Application No. 2001/0039516 to Bennett et al. in support of Official Notice, that paragraph discusses how a human sales representative could intervene in an online purchasing transaction and does not suggest how the customer sets of Henson could be converted into the virtual entitled groups of the independent Claims 3 and 4 of the claimed invention.

Conclusion

In view of the foregoing, Applicants submit that claims 3-4 and 6-10 are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed.

Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 50-0510 (IBM-Yorktown).

Respectfully submitted,



Michael E. Whitham

Registration No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190
Tel. (703) 787-9400
Fax. (703) 787-7557
Customer No.: 30743